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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,066	03/08/2001	Dewayne Baker	CCHA-1	5283

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EXAMINER

OYEBISI, OJO O

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,066

Applicant(s)

BAKER ET AL.

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 03/08/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/08/2001 and 8/24/01
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-11** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The rejected claims appear to be directed to computer program.

Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claims 1-11 are therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 1-11 language

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that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over

CHECK ADJUSTMENT REQUEST FEDERAL RESERVE BANK (Paper Adj hereinafter:

http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf)

in view of Electronic Check Adjustments Federal Reserve Bank (Electronic Adj

hereinafter: <http://www.stlouisfed.com/publications/pq/1998/a/pq1998a5.html>).

Re Claim 1: Paper Adj discloses a manual exchange system for processing cash letter

adjustments between a plurality of authorized financial institutions, including a sender

institution, a receiver institution and a central exchange center, said system comprising:

means for entry of adjustment data into said system, said data including sender

institution information, receiver institution information, adjustment amount information,

and data validation information, processor means for processing said adjustment data,

said processing means including sorting means for sorting said data by sender

institution and receiver institution (i.e., finesort, pg 1) (see

http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf,

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pg 1). Paper Adj does not explicitly disclose an electronic exchange system comprising: processing means for validation of said data, and, notification means for notifying said sender institution and said receiver institution of adjustment data after successful validation by said processing means. However, Electronic Adj discloses an electronic exchange system comprising: processing means for validation of said data (i.e., verifies the data, see <http://www.stlouisfed.com/publications/pq/1998/a/pq1998a5.html>, pg 2), and, notification means for notifying said sender institution and said receiver institution of adjustment data after successful validation by said processing means (see <http://www.stlouisfed.com/publications/pq/1998/a/pq1998a5.html>, pg 2&3). It would have been obvious to one of ordinary skill in the art to implement the manual adjustment process of Paper Adj in the electronic adjustment system of Electronic Adj to guarantee delivery and to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Re Claim 2: Paper Adj further discloses that the said processor means includes calculation means for determining net adjustments between said sender institution and said receiver institution except that this calculation is done manually. Electronic Adj discloses an electronic exchange system of claim 1. Therefore, it would have been obvious to one of ordinary skill in the art to implement the manual calculation done in Paper Adj in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual

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activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply calculating the net adjustments electronically gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

Re Claim 3: Paper Adj discloses an exchange system of claim 2 wherein said exchange system includes an account system for adjustment of accounts of said sender institution and said receiver institution by said net adjustment amount (see http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf, pg 1) . Paper Adj does not explicitly disclose an electronic exchange system wherein said notification means includes notifying said central exchange of said net adjustment. However, Electronic Adj discloses an Electronic exchange system wherein said notification means includes notifying said central exchange of said net adjustment (see <http://www.stlouisfed.com/publications/pq/1998/a/pq1998a5.html>, pg 2&3). Therefore, it would have been obvious to one of ordinary skill in the art to implement the manual account system of Paper Adj in the Electronic system of Electronic Adj to speed up the adjustment process.

Re Claim 4: Paper Adj discloses the system of claim 1 wherein said adjustment data includes one or more adjustment transactions selected from the group: enclosed items not listed, listed items not enclosed, encoding errors, misread errors, documentation errors (i.e., listing errors, pg 1), and requests for information (see http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf,

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pg 1). Insofar as the claim recites "includes one or more", it is immaterial whether or not the other elements are also disclosed. Paper Adj does not expressly show automating the adjustment transactions selected group above. However, Electronic Adj discloses an electronic exchange system. Therefore, it would have been obvious to one of ordinary skill in the art to implement Paper Adj's adjustment transactions selected group in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).). For example, simply automating the adjustment transactions field tags to include: enclosed items not listed, listed items not enclosed, encoding errors, misread errors, documentation errors, and request for information, gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

Re Claim 5: Paper Adj discloses the system of claim 4 wherein said data includes information selected from the group: the date of submission, sender routing number (i.e., ABA # (FCL), pg 1), sender institution name, and receiver institution name (see http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf) . Paper Adj does not expressly show automating the information selected group above. Electronic Adj discloses an electronic exchange system. Therefore, it would have been obvious to one of ordinary skill in the art to implement Paper Adj's information selected group described above in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to

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replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the information selected field tags to include: the date of submission, sender routing number, sender institution name, and receiver institution name, gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

Re Claim 6: Paper Adj discloses the system of claim 1 wherein said validation information includes a series of business rules (i.e., Do not submit errors of \$15 or less, pg 1) and information requirements (i.e., research information, pg 1) utilized by said processor means (see http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf) except that this validation information are in paper form. However, Electronic Adj discloses an electronic exchange system. Therefore, it would have been obvious to one of ordinary skill in the art to implement validation information described above in paper form in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the validation information field tags to include a series of business rules and information requirements gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

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Re Claim 7: Paper Adj discloses the system of claim 6 wherein said business rules include amount limits on adjustment (i.e., do not submit errors of \$15 or less) for different member institutions (see http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf) except these rules are on paper. However, Electronic Adj discloses an electronic exchange system. Therefore, it would have been obvious to one of ordinary skill in the art to implement the rules described above in paper form in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the business rules gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

Re Claim 8: Paper Adj discloses the system of claim 4 wherein said listed items not enclosed adjustment includes at least two or more of the following data: total amount of adjustment; cash letter creation date; cash letter type; cash letter total dollar value listed; missing item adjustment; missing bundle adjustment; tape listing type; tape total dollar (see http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf) except that listed items not enclosed adjustment data are on paper. Insofar as the claim recites "includes at least two or more ", it is immaterial whether or not the other elements are also disclosed. However, Electronic Adj discloses an electronic exchange

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system. One of ordinary skill in the art would have obviously know that listed items not enclosed adjustment data on paper can be implement in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the adjustment data to include total amount of adjustment; cash letter creation date; cash letter type; cash letter total dollar value listed; missing item adjustment; missing bundle adjustment; tape listing type; tape total dollar gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

Re Claim 9: Paper Adj discloses the system of claim 8 wherein said listed items not enclosed includes itemization of the dollar amount of the specific item or bundle (i.e., tape total (TT), pg 1); the dollar amount of the item before the subject item; the dollar amount after the subject item; and the sequence/trace number (i.e., sequence (SEQ), pg 1) that was applied to the item in the cash letter preparation process (see http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf) except that these items are on paper. However, Electronic Adj discloses an electronic exchange system. One of ordinary skill in the art would have obviously know that "listed items not enclosed" mentioned above can be implemented in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ

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193, 194 (CCPA 1958). For example, simply automating the adjustment data to include itemization of the dollar amount of the specific item or bundle; the dollar amount of the item before the subject item; the dollar amount after the subject item; and the sequence/trace number that was applied to the item in the cash letter preparation process gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

Re Claim 10: Paper Adj discloses the system of claim 9 comprising: "item before", "item after" and "bundle/tape" total field of the transaction section (see

http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf)

. Paper Adj does not explicitly disclose that the combined total of all "item before" and "item after" cannot exceed the amount entered in the "bundle/tape" total field of the transaction section. However, since "item before" is the item preceding reported item on detail listing and "item after" is the item following reported item on detail listing.

Obviously, if the adjustment is done correctly the combined total amount of "item before" and "item after" cannot exceed the bundle total amount. However, if it does exceed, the adjustment has to be re-adjusted. Furthermore, since the process of making sure that the combined total amount of "item before" and "item after" cannot exceed the total bundle amount can be done manually, simply automating this process gives you just what you would expect from the manual step. Therefore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In other words, there is no enhancement

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found in the claimed step.

Re Claim 11: Paper Adj discloses the system of claim 4 wherein said adjustment data includes one or more adjustment transactions selected from the group: empty carrier; error in addition; misdirected return; non-negotiable item; "not our item"; "photo in lieu of original"; "photo: original paid"; free item; and reversal (see

http://www.richmondfed.org/financial_services/check/adjustments/pdf/request_form.pdf)

except that these adjustment transactions field tags are on paper. Insofar as the claim recites "includes one or more ", it is immaterial whether or not the other elements are also disclosed. Electronic Adj discloses an electronic exchange system. One of ordinary skill in the art would have obviously know that said adjustment data described above can be implemented in Electronic Adj to speed up the adjustment process. Furthermore, the examiner takes notice that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the adjustment data to include one or more adjustment transactions selected from the group: empty carrier; error in addition; misdirected return; non-negotiable item; "not our item"; "photo in lieu of original"; "photo: original paid"; free item; and reversal gives you just what you would expect from the manual step as shown in Paper Adj. In other words, there is no enhancement found in the claimed step.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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